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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,011	01/09/2001	Vassil Iliya Ognyanov	317743-103C	7091

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ALLEN BLOOM
C/O DECHERT
PRINCETON PIKE CORPORATION CENTER
P.O. BOX 5218
PRINCETON, NJ 08543-5218

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 09/09/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,011

Applicant(s)

OGNYANOV et al.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 24, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-74 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 43-74 are pending in the application.

This action is in response to applicants' amendment dated June 24, 2002. Claims 43, 46, 56, 61 and 66 have been amended and claim 42 has been canceled.

Response to Arguments

Applicants' arguments filed June 24, 2002 have been fully considered with the following effect:

1. With regards to the 35 USC § 112, first paragraph rejection of claims 43-45, 48-65 and 68-73 of the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicants stated that "the claimed subject matter was clearly intended to be claimed, and hence possession of the invention was conveyed, as one of ordinary skill would glean from examining compounds A15". The definition of the substitutions of R^{xa} , R^{ya} and R^{2a} is such that R^{xa} , R^{ya} and R^{2a} can be combined to form a **second** bridge between **two** of R^{xa} , R^{ya} and R^{2a} . The definition of R^2 fails to include the possibility of R^{xa} , R^{ya} and R^{2a} forming the third bridging structure as claimed herein, i.e. where the methylene or ethylene bridge between R^{xa} and R^{ya} can be substituted by R^2 when R^2 is ethylene to form the third bridging structure. The definition of R^2 in the species of example A15 which is a species with specific variables, is not a description of the genus of formula I. Additionally, recent case law *Tronzo v. Biomet* 47 USPQ2d 1829 states that a species in a prior application does not provide written description to a generic claim.

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Claims 43-45, 48-65 and 68-73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For reasons of record and stated above.

2. The applicant's amendments are sufficient to overcome the 112 second paragraph rejections of the last office action which are hereby **withdrawn**.

In view of the amendment dated June 24, 2002, the following new grounds of rejection apply:

Priority

3. When a non-provisional application is converted to a provisional application, the serial number of the converted non-provisional application should not be listed in the continuing data.

Clarification of the continuing data in the first line of the specification is requested.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 43-45, 48-65 and 68-73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The definition of R² includes the moiety (e) ethylene forming a third bridging structure, which is not described in the specification.

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 43-45, 48, 50-65 and 68-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 43-45, 48, 50-65 and 68-73 are vague and indefinite in that it is not known what is meant by the reference to (2ⁱⁱⁱ)(b)(i) in the definition of R². There is no paragraph labeled (2ⁱⁱⁱ)(b)(i) in the claim.
- b) Claim 62 is vague and indefinite in that it is not known what is meant by “the same substituents **defined above**”. However the substituents are not defined within the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 43-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Ognyanov et al., WO 97/45115. Ognyanov teaches the compounds, compositions and method of use of the compounds of the instant invention as shown by examples A32, A41, A140, A161, etc. It is recognized benefit under 35 USC 120 is being urged. However, claims 43-74 of instant application are only entitled to benefit of serial number 09/757,011 filed January 9, 2001 as it is only completely described in the instant application. Note *In re Scheiber* 199 USPQ 782 regarding 112 compliance for benefit under 35 USC 120.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
Primary Examiner AU 1624
September 5, 2002